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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,770	11/15/2001	R. Dennis Nesbitt	P-5915	4535

24492 7590 09/20/2004

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EXAMINER

GORDON, RAEANN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/003,770	<b>Applicant(s)</b> NESBITT, R. DENNIS	
	<b>Examiner</b> Raeann Gorden	<b>Art Unit</b> 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-7,9-14,16-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7,9-14,16-19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 9-14, 16-18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraoka et al (Re 35,293). Regarding claim 2, Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A). Polybutadiene (A) may be commercially available BUNA CB 10 (col 1, lines 52-67). According to applicant's spec page 11, table 3 BUNA CB 10 has a solution viscosity of  $140 \pm 20$  mPa\*s. The COR value is an obvious feature since the polybutadiene is identical to applicant's. Regarding claim 3, applicant appears to be claiming a method of production that is not relevant to the final product. However, any properties based on the polybutadiene are obvious since applicant's is identical to Hiraoka. Regarding claim 4, Hiraoka discloses a Mooney viscosity range from 45 to 90 (col 1, line 59) and applicant discloses BUNA CB 10 has a Mooney viscosity of  $47 \pm 5$  (spec table 3). Regarding line 5, the golf ball includes a cover (col 2, lines 58-61). Regarding claim 6, the polybutadiene has a 1-4 cis content of 80% or more (col 1, lines 53-55) and applicant discloses BUNA CB 10 has a 1-4 cis content of 96% or more (page 11, table 3). Regarding claim 7, the core composition includes a second polybutadiene (B)(col 2, lines 1-5). Regarding claim 9,

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the COR value is an obvious feature since the polybutadiene is identical to applicant's. Regarding claim 10, Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A). Polybutadiene (A) may be commercially available BUNA CB 10 (col 1, lines 52-67). According to applicant's spec page 11, table 3 BUNA CB 10 has a solution viscosity of  $140 \pm 20$ . The COR value is an obvious feature since the polybutadiene is identical to applicant's. Regarding claim 11, the polybutadiene has a 1-4 cis content of 80% or more (col 1, lines 53-55) and applicant discloses BUNA CB 10 has a 1-4 cis content of 96% or more (page 11, table 3). Regarding claim 12, applicant appears to be claiming a method of production that is not relevant to the final product. However, any properties based on the polybutadiene are obvious since applicant's is identical to Hiraoka. Regarding claim 13, the core composition includes a second polybutadiene (B)(col 2, lines 1-5). Regarding claim 14, Hiroaka discloses a Mooney viscosity range from 45 to 90 (col 1, line 59) and applicant discloses BUNA CB 10 has a Mooney viscosity of  $47 \pm 5$  (spec table 3). Regarding claims 16 and 17, Hiroaka discloses the method of making a golf ball including selecting BUNA CB 10 for the core material and molding the core composition (col 2, lines 55-60). The performance features of the core are obvious since the material is identical to applicants. Regarding claim 18, the features of the polybutadiene are obvious since the material is identical to applicants. Regarding claim 19, Hiroaka discloses a Mooney viscosity range from 45 to 90 (col 1, line 59) and applicant discloses BUNA CB 10 has a Mooney viscosity of  $47 \pm 5$  (spec table 3). Although Hiraoka does not disclose the COR, the feature is

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considered obvious since the first polybutadiene disclosed by applicant is identical to the polybutadiene disclosed by Hiroaka.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiraoka et al (Re 35,293) in view of Cadorniga et al (5,508,350). Hiraoka discloses a golf ball comprising a core made from a polybutadiene (A) and a second polybutadiene (B)(col 2, lines 1-5). Hiroaka further discloses up to 25% of the second polybutadiene but does not disclose the range claimed by applicant. Cadorniga teaches 50% of two different polybutadienes in a golf ball core. One of ordinary skill in the art would have increased the quantity of the second polybutadiene to achieve the desired properties of the core.

***Response to Arguments***

Applicant's arguments filed 6-1-04 have been fully considered but they are not persuasive. Applicant argues the first polybutadiene disclosed by Hiraoka only partially overlaps a range of solution viscosities recited in claim 2. Applicant's position is not understood. Claim 2 requires a polybutadiene (not the composition) must have a

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solution viscosity from about 90 mPa\*s to about 130 mPa\*s. The specification page 11, recites "Of the above described BUNA CB polybutadiene rubbers, the most preferred for a core composition is BUNA CB 10 polybutadiene rubber." Hiroaka clearly discloses BUNA CB 10 as an option for the first polybutadiene. Therefore it is unclear why applicant argues the polybutadiene only partially overlaps the range when the two are identical. With respect to the COR, applicant argues that since Hiroaka discloses two polybutadienes the COR would not necessarily be at least 0.780 as recited in claim 2. The Examiner disagrees. Tables 4 and 5, example 12 of the instant application discloses a core made from 100 parts of BUNA CB 10. The core has a COR value of 0.786. Hiroaka discloses a core made from BUNA CB 10 (poly A) and an additional rubber, wherein the BUNA CB 10 is present in the amount of 98 parts (col. 2). Therefore, it is clear the COR would obviously be the same, 0.786. If applicant believes it is not possible for the COR to be the same or at minimum within the claimed range of at least 0.780, applicant is encouraged to provide a declaration and/or data proving that 2 parts of the second polybutadiene in Hiroaka would decrease the COR below the claimed limit. With respect to claims 21-23, applicant's arguments are not persuasive. Claiming ranges for the quantity of each polybutadiene is not new or innovative in the golfing art as shown in the secondary reference, Cadorniga. Applicant contends one of ordinary skill in the art would not look to Cadorniga for quantity ranges. Clearly, Hiroaka discloses the base claims and further includes ranges for polybutadienes A and B in the amounts from 98/2 to **75/25**. Applicant claims from **70/30** to 50/50. The smallest difference between the two ranges is about 5 parts. Cadorniga teaches 50/50 of

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polybutadienes A and B. Since both patents are golf balls comprising cores with two different polybutadienes the art is analogous and the combination is proper.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rg  
September 16, 2004



**RAEANN GORDEN**  
**PRIMARY EXAMINER**